

REMARKS

The Examiner identified three separate inventions, Group I comprising claims 1-14, Group II comprising claims 15-20 and Group III comprising claims 21-27. The Examiner also identified a number of different species in each Group. Based on the requirements of 35 U.S.C. § 121, the Examiner required restriction to a single invention and a single disclosed species for prosecution on the merits. During a telephone conference March 18, 2004, Applicant elected Species 1 (claims 15 & 16) in Group II. In the March 30, 2004 Office Action, the Examiner rejected claims 15 and 16 under 35 U.S.C. § 102(b) as being anticipated by Such (U.S. Patent No. 5,457,751). The Examiner also rejected claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Larson (U.S. Patent No. 5,608,794) in view of Such. In response, the Applicant has cancelled claims 1-14, 17 and 21-27, added new claims dependent on claim 15 and has set forth arguments supporting the patentability of the claims in light of the prior art. The Applicants believe the amendments made in response to the Examiner's rejections have placed the application in position for allowance.

Restriction Requirement

With regard to the restriction requirement under 35 U.S.C. § 121, the Applicant has selected Group II, comprising claims 15-20 and, more specifically, the specie identified as claims 15 and 16. Originally, all claims in Group II depended from claim 15. In this response, claim 15 is being amended to incorporate the limitations of the original claim 16 (i.e., the elongated extension member connected to the ear hook). The remaining claims, including the new claims, depend from the amended claim 15, directly or indirectly. Applicant believes that this response complies with the Examiner's restriction requirement.

Amendments to Claims 15 and 16

25 In addition to the above-described amendment (i.e., incorporating the limitation of
26 claim 16 into independent claim 15), Applicant is amending claim 15 to clarify that the earpiece is

27 || RESPONSE/AMENDMENT

Appl. # 09/009 911

1 attached to the ear hook and is operatively connected to the telephone unit such that it can transmit
2 sound from the telephone unit into an ear of the user and that the extension member extends generally
3 upward from the headset. Claim 16 is being amended to include the limitation that the extension
4 member is generally elongated.

5

6 Rejection under 35 U.S.C. § 102(b)

7 With regard to the rejection of claims 15 and 16 (now claim 15) under 35 U.S.C. §
8 102(b) as being anticipated by Such, the Applicant respectfully disagrees with the Examiner. Such
9 does not disclose each and every element of Applicant's claimed invention as required for a Section
10 102(b) rejection. (See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 221
11 USPQ 481, 485 (Fed. Cir. 1984); W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303,
12 313 (Fed. Cir. 1983).) In particular, with regard to claim 15 Such does not disclose the use of a light
13 source electrically connected to the telephone unit for indicating when the telephone unit is in an off-
14 hook condition (i.e., in use by the user). With regard to new claims 29-34, Such does not disclose a
15 headset configured according to claim 15 wherein the ear hook is configured to at least partially
16 encircle the user's ear, extension member extend above the head of the user, the light source is above
17 the user's head and at least a portion of the extension member includes a fiber optic cable configured
18 to transmit light therethrough.

19 Such discloses an ergonomic headset configured to be worn around the back of the
20 head and supported, in part, by the user's ears. Figure 7, referenced by the Examiner, discloses an
21 embodiment that includes the left ear supported member 15, right ear supported member 16, a
22 microphone 40' at the end of boom 12, earphone 40 and a second boom 12' having a visual device 13
23 at the distal end thereof. As set forth in the Such specification at column 7, line 55 through column
24 8, line 3, the inventor states that the visual device could be a simple mirror so that the user can watch
25 events taking place behind him/her. Alternatively, device 13 can be a screen so the user can both see
26 in front of him/her and monitor other events on the visual device as well (i.e., airplanes from the

27 RESPONSE/AMENDMENT

Appl. # 09/909,911

1 tower for an air traffic controller). At column 4, lines 9 through 40, the inventor describes other
2 possible devices that are capable of receiving voice or other human input or being capable of
3 supplying output to the ears and eyes. Despite the number of devices identified in Such, there is no
4 mention or suggestion of utilizing a light source that is electrically connected to the telephone unit to
5 indicate when the telephone unit is in an off-hook condition (i.e., in use by the user) so as to let
6 others know that the user is “talking on” the telephone to avoid disturbing the user while using the
7 telephone. Such is directed towards a telephone headset that is configured to carry audio/visual
8 devices on the user’s head, but not to a device that functionally interacts with the telephone unit to
9 light a signal when the telephone is in use. In addition, the headset of Such does not encircle the
10 user’s ear, does not have an extension member that extends in a generally upwardly direction during
11 use (Such does describe pivoting the visual device 13 out of the way when the user wants an
12 unobstructed view, but this is clearly done when the visual device 13 is not in use) and does not have
13 a portion of the boom (or extension member) made out of a fiber optic cable.

14 Having a light source that is electrically connected to the telephone unit to indicate that
15 the telephone unit is in an off-hook condition to let others know that the user is talking on the
16 telephone is the primary feature that distinguishes Applicant’s invention from other telephone headset
17 devices that are presently in use or available. The present application is directed to such a light
18 source that is on, in, attached to or integral with an extension member connected to an ear hook that
19 supports the headset on the head of the user. As set forth in Applicant’s disclosure, with current
20 headsets it is often very difficult for others to determine whether the user is merely sitting/standing
21 with the headset on his/her head or that he/she is actually engaged in a conversation with another
22 person. Typically, while the other person on the telephone is speaking, the user is not. This silence
23 makes it very difficult for a person approaching the user to know whether the user is on the telephone
24 prior to disturbing them. Even when the user is speaking, unless the user is speaking loud enough for
25 others to hear or facing a direction such that others can see his/her lips move, it can be very difficult
26 for others to know if the user is talking on the telephone or between telephone calls.

27 RESPONSE/AMENDMENT

Appl. # 09/909,911

1 As set forth above, Such does not disclose each and every element of Applicant's
2 claimed invention. Further, in order to serve as a reference under 35 U.S.C. § 102(b), the reference
3 must be enabling as to the features to which anticipation is suggested. (Akzo N.V. v. U.S. Int'l Trade
4 Comm., 1 USPQ2d 1241, 1245 (Fed. Cir. 1986); In re Donohue, 226 USPQ 619, 621-22 (Fed. Cir.
5 1985); W.L. Gore & Associates, Inc., 220 USPQ at 314.) Anticipation cannot be predicated on mere
6 conjecture regarding the characteristics of various features of the invention disclosed in the reference.
7 (See W.L. Gore & Associates, Inc., 220 USPQ at 314.) With regard to Applicant's invention, Such
8 fails, as a single reference, to support a 102(b) rejection and, therefore, does not anticipate the claims
9 Applicant's patent application. Such does not disclose a light source electrically connected to the
10 telephone unit and it is non-enabling as to that feature because it does not function to accomplish the
11 expressed objectives of Applicant's invention. Specifically, the visual device of Such is not
12 electrically connected to the telephone unit for indicating when the telephone unit is in an off-hook
13 condition. There is no suggestion in Such that the ergonomic headset could be used to indicate to
14 third persons that the user of the headset is on the telephone and should not be disturbed. As such,
15 respectfully, Applicant is of the opinion that Such does not anticipate her invention.

16

17 Rejection under 35 U.S.C. § 103(a)

18 With regard to the obviousness rejections for claims 15 and 16, which is based on
19 Larson in view of Such, Section 103(a) only denies patentability to those inventions whose "subject
20 matter as a whole would have been obvious at the time the invention was made to a person having
21 ordinary skill in the art to which said subject matter pertains." (35 U.S.C. § 103.) As set forth
22 above, the teachings from Such are not reasonably pertinent to the problems solved by Applicant's
23 invention. (See In re Clay, 23 USPQ2d 1058, 1060 (CAFC 1992).) Although Such discloses a
24 telephone headset, it is not configured or intended to be utilized to indicate to others that the telephone
25 unit is in use so the user will not be unnecessarily disturbed. Because the subject matter and purpose
26 of Applicant's invention is different than the subject and purpose of the invention in Such, an inventor

27

RESPONSE/AMENDMENT

Appl. # 09/909,911

1 would not have been motivated to look to or consider this patent in attempting to solve the problems
2 solved by Applicant's invention. (See In re Clay, 23 USPQ2d at 1061.) As a result, a person having
3 ordinary skill in the art would not apply the teachings of Such to Larson so as arrive at Applicant's
4 invention and nothing in Such suggests such an application, particularly in light of the differences
5 between Such and Applicant's invention.

6 Even if the Such reference is considered is analogous art, respectfully, nothing suggests
7 combining the teachings of Such with Larson, as suggested by the Examiner, to arrive at Applicant's
8 invention. As stated by the court in In re Geiger, 2 USPQ2d 1276 (CAFC 1987), "[o]bviousness
9 cannot be established by combining the teachings of the prior art to produce the claimed invention,
10 absent some teaching, suggestion or incentive supporting the combination." (In re Geiger, 2 USPQ2d
11 at 1278.) The motivation or suggestion to combine references must exist, otherwise the determination
12 of obviousness involves nothing more "than indiscriminately combining prior art." (Micro Chemical
13 Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244 (CAFC 1997).) In In re Fritch, 23
14 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the following:

15 In proceedings before the Patent and Trademark Office, the Examiner bears the burden of
16 establishing a *prima facie* case of obviousness based upon the prior art. The Examiner can
17 satisfy this burden only by showing some objective teaching in the prior art or that knowledge
generally available to one of ordinary skill in the art would lead that individual to combine the
relevant teachings of the references.

18 Obviousness cannot be established by combining the teachings of the prior art to produce the
claimed invention, absent some teaching or suggestion supporting the combination. Under
19 section 103, teachings of references can be combined *only* if there is some suggestion or
incentive to do so. Although couched in terms of combining teachings found in the prior art,
20 the same inquiry must be carried out in the context of a purported obvious "modification" of
the prior art. The mere fact that the prior art may be modified in the manner suggested by the
21 Examiner does not make the modification obvious unless the prior art suggested the
desirability of the modification.

22 Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is
impermissible to use the claimed invention as an instruction manual or "template" to piece
23 together the teachings of the prior art so that the claimed invention is rendered obvious. This
court has previously stated that one cannot use hindsight reconstruction to pick and choose
24 among isolated disclosures in the prior art to deprecate the claimed invention. (In re Fritch,
25 23 USPQ2d at 1783-84 (internal quotes and citations removed).)

1 Respectfully, nothing in Such, Larson or any knowledge generally available to one of
2 ordinary skill in the art compels, teaches, suggests or even offers any incentive such that an individual
3 wanting to invent a headset with an upwardly extending extension member having a light source
4 electrically connected to the telephone unit for indicating when the telephone unit is in an off-hook
5 condition, as set forth in Applicant's invention, would combine the teachings from Such with those
6 from Larson. (See In re Fritch, 23 USPQ2d at 1783; In re Geiger, 2 USPQ2d at 1278.) A person
7 wanting to solve the problem solved by Applicant's invention (i.e., a telephone headset having a
8 signal light on, in, attached to or integral with an extension member extending generally upwardly
9 from the headset) would not look to a reference (such as the Such patent) directed to a headset that has
10 a mirror or display screen that extends in front of the user's face that is configured for the user to
11 utilize the visual device. Although the Larson reference does teach a headset 14 having a light source
12 20 (busy indicator lamp) on or in the same arm/boom 18 used to support and place the mouthpiece 19
13 in front of the user's mouth, Larson does not teach or even suggest providing a separate extension
14 member connected to an ear hook configured headset such that the extension member extends
15 generally upwardly from the headset. Instead, Larson merely places a light at the end or inside the
16 microphone boom that is utilized with the typical or standard telephone headset. As a result, viewing
17 the Larson and Such references and determining that it would have been obvious to combine them to
18 achieve Applicant's invention may, respectfully, be an application of impermissible hindsight to arrive
19 at the determination of obviousness. (See In re Fritch, 23 USPQ2d at 1784.) Applicant believes that,
20 at the time of Applicant's invention, a person skilled in the art would not have combined these
21 references in this manner (even assuming one would look to Such).

22 In light of the above arguments, Applicant respectfully requests the Examiner to
23 withdraw the rejection of the claims set forth in the subject patent application.

24 Applicant's original application included fees for four (4) independent claims and a
25 total of 27 claims. After this amendment, a total of 18 claims, including two (2) independent claims
26 are pending in this application. As such no additional fees for claims are believe due.

27 RESPONSE/AMENDMENT

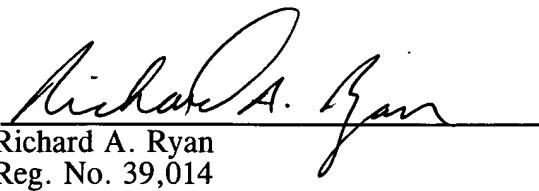
Appl. # 09/909,911

1 In view of the foregoing, it is submitted that this application is in condition for
2 allowance. Reconsideration of the rejections and objections in light of this Amendment is requested.
3 Applicant believes that the amended claims are in condition for allowance. Allowance of claims 15,
4 16, 18-20 and 28-40 is respectfully solicited.

5

6 Dated: June 30, 2004

7 Respectfully Submitted,

8 By 
9 Richard A. Ryan
10 Reg. No. 39,014

11 Ryan & Engnath
12 8469 N. Millbrook, Suite 104
13 Fresno, CA 93720

14 Phone: (559) 447-1862
15 Fax: (559) 447-1042
16 e-mail: richard@ryanengnath.com